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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/713,545	11/13/2003	William Lawrence Whittaker	02-626-US	7960

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EXAMINER

LEE, JONG SUK

ART UNIT	PAPER NUMBER
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3673

DATE MAILED: 02/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/713,545

Applicant(s)

WHITTAKER ET AL.

Examiner

Jong-Suk (James) Lee

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 December 2004.
2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-22 is/are pending in the application.
4a) Of the above claim(s) 2-8 and 19-22 is/are withdrawn from consideration.
5) ☐ Claim(s) _____ is/are allowed.
6) ☒ Claim(s) 1 and 9-18 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 1/19/2005.
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restriction

1. Applicant's election with traverse of Species A (Figs. 2A-2B) directed to claims 1 and 9-18 in the reply filed on December 27, 2004 is acknowledged.

The traversal is on the ground(s) that Species A reads upon pending claims 1-22 and further, claim 9 is generic to Species A, B and C, such as Figures 2A-2B, 9A-9B and 11A-11B. This is not found persuasive because Species A clearly shows the anchoring device and the anchoring step, for example, independent claim 1 recites the method steps, "loading.....**anchoring said lateral device to the at least one lateral pipe.....utilizing.....and unloading.....**" and independent claim 9 recites the lateral device having a housing and **an anchor device to secure the housing to an inner wall.**

However, claims 2-8 do not provide any "anchoring" step and claims 19-22, as understood, do not include the anchoring device and rather, merely recites the method step of cutting the lateral to be open with the cutting device and/or delivery device, which are drawn to Figs. 9A-B and 11A-B. Further, in claim 19, the limitation, "said at least one lateral cutting device" in lines 4-5 and "said device carrier" in line 7 lack of antecedent basis.

Therefore, claims 2-8 and 19-22 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected species, there being no allowable generic or linking claim.

The requirement is still deemed proper and is therefore made FINAL.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claim 17 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Re claim 17: The limitation, "said work device" in lines 1-2 lack clear antecedent basis. It is suggested to be -- said work tool --.

Appropriate correction is required.

Claim Rejections - 35 USC § 102

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --
(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

5. Claims 9, 10, 12, 13, 15, 17 and 18 are rejected under 35 U.S.C. 102(b) as being anticipated by Endoh (US 5,520,569).

Endoh discloses a cutter and a rotary cutter apparatus in a pipe system comprising a lateral device housing (30), an anchor device/skid (Fig. 4) to secure said housing to an inner wall of a first pipe (15) which intersects with a second pipe (16), a work tool (1), wherein said work tool is a rotary bit cutting tool or hole saw or grinding cutting tool, wherein said work tool is an

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electrically generated signal source, the device further comprising an onboard power source device from the lateral device for powering said work, wherein a state of said work tool is determined based on local decision-making (31, 32, 35) from on board the lateral device (see Figs. 1-17; col.2, lines 3-63; col.4, lines 39-67; col.5, lines 1-67; col.6, lines 1-9).

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 9, 16 and 17 are rejected under 35 U.S.C. 102(e) as being anticipated by Warren (US 6,695,013).

Warren discloses a method and device for lining a lateral sewer pipe with lateral comprising a lateral device/work tool (16) being loaded into at least one lateral pipe (124) from the main pipe (112), the lateral device being anchored to the at least one lateral pipe with an inflatable member (14), the lateral device being utilized to perform work on or within the at least one lateral pipe, and the lateral device being unloaded from the at least one lateral pipe to the main pipe, wherein the work tool being an attachment adapted to drag a liner (46) up into the first pipe/lateral (124) from the second pipe/main (112), an onboard power source for powering the work device (tool) from the lateral device (see Figs. 1-9; col.3, lines 66-67; col.4, lines 1-67; col.5, lines 1-5; col.6, lines 65-67; col.7, lines 1-13).

Claim Rejections - 35 USC § 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 11 and 14 are rejected under 35 U.S.C. 103(a) as being unpatentable over Endoh in view of Driver (US 5,318,395). The teachings of Endoh have been discussed above.

However, Endoh fails to disclose or fairly suggest a rotating arm supporting said rotary bit cutting tool or the grinding/cutting device being spring biased/tensioning against the inner wall of the pipe. Driver discloses a method and apparatus for porting a lateral connection comprising a rotating arm (601', 602') supporting said rotary bit cutting tool (850) or the grinding/cutting device being spring (690) biased/tensioning against the inner wall of the second/lateral pipe (33) (see Figs. 6-11; col.4, lines 1-67; col.5, lines 1-62; col.6, lines 13-41).

Therefore, in view of Driver, it would have been obvious to one of the ordinary skill in the art at the time the invention was made to replace the cutting tool of Endoh with the cutting tool as taught by Driver in order to enhance the cutting efficiency with better contact between the tool and inner wall of the pipe.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Other references cited disclose an apparatus for inspecting lateral sewer pipe, an


apparatus and method for repairing the junction of a sewer mainline and lateral pipe and a conduit line cutter.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jong-Suk (James) Lee whose telephone number is (703) 308-6777. The examiner can normally be reached on 6:30 am to 3:00 pm, Monday thru Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jong-Suk James can be reached on (703) 308-6777. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

J. Lee /jjl
February 2, 2005



Jong-Suk (James) Lee
Primary Examiner
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